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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,267	10/27/2004	Ryoto Shima	TSL 1786 US	5304

8131 7590 12/13/2007  
MCKELLAR IP LAW, PLLC  
784 SOUTH POSEYVILLE ROAD  
MIDLAND, MI 48640

EXAMINER
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NGUYEN, KHANH TUAN

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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12/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p align="center">10/509,267</p>	<p><b>Applicant(s)</b></p> <p align="center">SHIMA ET AL.</p>	
	<p><b>Examiner</b></p> <p align="center">Khanh T. Nguyen</p>	<p><b>Art Unit</b></p> <p align="center">1796</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Final*

### *Response to Amendment*

1. The amendment filed on 10/03/2007 is entered and acknowledged by the Examiner. Claims 1-26 are currently pending in the instant application.
2. The rejection of claims 1-26 under 35 U.S.C 102(b) is withdrawn in light of applicants amendment and remarks.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al. (U.S Pat. 5,082,596 hereinafter, "Fukuda") in view of Azechi et al. (U.S Pub. 2002/0049274 hereinafter, "Azechi").

With respect to instant claims 1-4 and 8, Fukuda teaches an electrically conductive silicone rubber composition comprising of (a) 100 to 500 parts of diorganopolysiloxane having at least two alkenyl groups per molecule (Col. 2, lines 57-67 and Col. 3, lines 1-14), (b) spherical silicone rubber particles with the ratio of (a) to (b) from 95:5 to 50:50 (Col. 3, lines 15-27 and Col. 4, lines 1-2), (c) 5 to 100 parts by weight of carbon black (Col. 4, lines 44-56), (d) a curing agent (Col. 4, lines 57-61). Component (b) is a spherical silicone rubber particles that may optionally be subjected to a surface treatment with surface active agent (Col. 3, lines 39-65). Fukuda also discloses platinum catalyst may be used to promote curing (Col. 5, lines 1-4). Fukuda

further teaches the finely divided electroconductive material conventionally compounded in an electroconductive silicone rubber composition include carbonaceous powder such as carbon blacks and graphite powders, powders of a metal such as silver, nickel, copper, and the like, carbon fibers, metal fibers, and non-electroconductive particles and fiber plated with a metal on the surface (Col. 1, lines 35-42). Moreover, the disclosure of Fukuda's component (b) spherical silicone rubber particles which were subjected to a surface treatment with surface active agent is construed to read on the claimed spherical silicone particles with a surface active agent content of not more than 0.3 wt%.

The difference between the prior art and the instant claimed invention is that Fukuda failed to teach an electrically conductive silicone rubber composition comprising a metal base electrically conductive filler in the claimed amount of 300 to 5,000 parts by weight.

In an analogous art, Azechi teaches an electrically conductive silicone rubber composition which comprises of 30 to 700 parts by weight of a metal powder or an electrically conductive metal-plated powder (Component C) ([0011], [0085]). The said metal powder or said electrically conductive metal-plated powder (i.e. metal base electrically conductive filler) may include metal powder (e.g. silver, gold, or nickel powder) or inorganic fillers plated with Ag, Au, or Ni ([0029] and [0032]). Azechi teaches the inorganic conductive filler such as carbon black and/or silicone rubber powder may be used together with the above mentioned conductive metal powders [0084]. Azechi

teaches the metal powder of component C is used to confer the silicone rubber composition with electrical conductivity [0026].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the metal powders of Azechi in its optimal proportion into the electrically conductive silicone rubber composition of Fukuda because Fukuda specifically teach other electroconductive material (Col. 1, lines 35-42) and Azechi teaches such metal powder to provide adequate electrical resistance.

Regarding claim 7, the component (F) is an optional component in the composition (Specification, paragraph 0018). Therefore, it is not required in the composition. Nonetheless, Azechi teaches a reaction regulator (i.e. reaction inhibitor) [0124].

Regarding claims 5, 6, 10, and 20-26, the subject matter would have been obvious to the skilled artisan because the patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See *In re Thorpe*, 227 USPQ 964 (CAFC 1985); *In re Marosi et al*, 218 USPQ 289; *In re Pilkington*, 162 USPQ 145. "The lack of physical description in a product-by-process claim makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not the process that must be established.

We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 173 USPQ 685,688 (CCPA 1972).

Regarding claims 9 and 11-19, Fukuda further discloses the conductive silicone rubber composition can be shaped and cured by molding method such as compression molding, transfer molding, extrusion molding, injection molding, calendaring and useful in applications in the office machines such as rollers of xerographic copying machines and keyboard coverings of pocketable calculators, electric and electronic instruments such as terminals of computers, transportation machines such as parts of automobiles and as well as in form of semiconductive rubber parts used for antistatic purpose (Col. 5, lines 53-67). In addition, it has been held that the recitation that an element is "adapted to" perform or is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. The recitation of a new intended use for an old product does not make a claim to that old product patentable, see In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

***Response to Arguments***

5. Applicant's arguments filed on 10/03/2007 have been fully considered but are moot in view of the new ground(s) of rejection set forth above.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh T. Nguyen whose telephone number is (571) 272-8082. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*hw*

KTN  
11/29/2007

*Lorna M. Douyon*  
LORNA M. DOUYON  
PRIMARY EXAMINER